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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Keith Wehmeyer
Serial Number: 09/981,000
Atty. Docket: RCA 89,027
Filing Date: December 3, 2001
For: DBS FEATURE EXTENSION ARCHITECTURE
Art Unit: 2623
Examiner: Jason Salce

APPEAL BRIEF

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Sir:

In response to the Office Action dated September 25, 2006, and further to the Notice of Appeal filed on November 9, 2006, Appellant hereby submits an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

I. Real Party in Interest

The real party in interest is Thomson Licensing Inc.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-5 are pending in this application, and are rejected. Claims 6-14 are subject to a restriction requirement and are withdrawn from consideration. The rejection of claims 1-5 is being appealed.

IV. Status of Amendments

An amendment subsequent to the final rejection of March 27, 2006 was filed on May 30, 2006, and was not entered. Thereafter, an amendment and a request for continued examination under 37 CFR 1.114 was filed on July 17, 2006, and was entered.

V. Summary of Claimed Subject Matter

The claimed subject matter relates to a method for forming a combined program guide in a stand-alone internet receiver 32. The stand-alone internet receiver 32 receives internet data and analog program information including first program guide information, and is coupled to a stand-alone digital video receiver 10 that receives digital program information including second program guide information (see, for example, FIG. 1, page 3, lines 21-29, page 4, lines 17-22, and page 9, lines 1-9). The stand-alone internet receiver 32 receives the first program guide information from a first signal source and receives the second program guide information from the stand-alone digital video receiver 10. The stand-alone digital video receiver 10 receives the second program guide information from a second signal source (see, for example, page 9, lines 1-9). The stand-alone internet receiver 32 integrates the first program guide

information with the second program guide information to form the combined program guide, and outputs data representative of the combined program guide to a display device (see, for example, FIG. 1 and page 9, lines 7-9).

VI. Ground of Rejection to be Reviewed on Appeal

The following grounds of rejection are presented for review in this appeal:

1. The rejection of claims 1-2 and 5 under 35 U.S.C. §103(a) based on U.S. Patent No. 5,801,787 issued to Schein et al. (hereinafter, "Schein") in view of U.S. Patent No. 6,058,430 issued to Kaplan (hereinafter, "Kaplan"); and
2. The rejection of claims 3 and 4 under 35 U.S.C. §103(a) based on Schein in view of Kaplan, and further in view of U.S. Patent No. 6,219,839 issued to Sampsell (hereinafter, "Sampsell").

VII. Argument

A. Patentability of Claims 1-2 and 5

The rejection of claims 1-2 and 5 under 35 U.S.C. §103(a) based on the proposed combination of Schein and Kaplan should be reversed for at least the following reasons.

First, one of ordinary skill in the art would have absolutely no motivation to combine the references in the manner proposed by the Examiner. As such, the instant rejection is the product of impermissible hindsight reconstruction, and should be reversed. It is first noted that independent claim 1 defines:

"In a stand-alone internet receiver for receiving internet data and analog program information including first program guide information, coupled to a stand-alone digital video receiver for receiving digital program information including second program guide information, a method for forming a combined program guide comprising steps of:

receiving the first program guide information from a first signal source;

receiving the second program guide information from the stand-alone digital video receiver, wherein the stand-alone digital video receiver receives the second program guide information from a second signal source;

integrating the first program guide information with the second program guide information to form the combined program guide; and outputting data representative of the combined program guide to a display device.”

As indicated above, independent claim 1 defines a method for forming a combined program guide using a stand-alone internet receiver coupled to a stand-alone digital video receiver. In formulating the instant rejection, the Examiner relies on cable box 16 of Schein as corresponding to the claimed “stand-alone internet receiver” (see page 3 of Office Action dated September 25, 2006). The Examiner admits, however, that cable box 16 of Schein fails to receive internet data (see page 4 of Office Action dated September 25, 2006). To cure this deficiency, the Examiner then relies on Kaplan. In particular, the Examiner states:

“... it would have been obvious to a person of ordinary skill in the art, to modify the stand-alone cable box receiver [i.e., cable box 16], as taught by Schein to, further receive internet data through the VBI [i.e., vertical blanking interval] of the analog signal received by the cable box (thereby providing an internet receiver), as taught by Kaplan” (see page 5 of Office Action dated September 25, 2006)

In response, Appellants note that one of ordinary skill in the art would have absolutely no motivation to modify Schein using Kaplan in the proposed manner since such a modification would prevent cable box 16 of Schein from receiving program guide information via the VBI, and thereby at least partially defeat one of the primary objectives of Schein, namely, the ability to receive and process program guide information from multiple sources including cable box 16. More specifically, modifying cable box 16 of Schein to use scan lines 10 through 20 of the VBI to receive internet data, as taught by Kaplan (see column 4, lines 35-41), would prevent cable box 16 from using those scan lines to receive program guide information. As a result, television schedule guide system 10 of Schein would be rendered at least partially inoperable for one of its primary objectives since cable box 16 would be unable to receive program guide information via the VBI. Accordingly, one of ordinary skill in the art would have absolutely no motivation to modify Schein in the proposed manner using the teachings of Kaplan.

In response to the foregoing argument, the Examiner argues:

“The examiner disagrees and notes that Applicant has provided no evidence as to why both a URL (or other types of Internet data) as well as program guide information could not both be provided over the VBI of a television channel. Additionally, the examiner notes that Kaplan teaches transmitting both program information data and Internet data (addresses) over the VBI (see Column 3, Lines 8-10, Column 4, Lines 33-41 and Column 6, Line 66 through Column 7, Line 3 for additionally providing program information related to the television program that a website was accessed from), therefore, the combination of Schein and Kaplan is proper and one of ordinary skill in the art would not find such a combination counter-intuitive.” (see pages 2-3 of Office Action dated September 25, 2006)

In response to the Examiner's foregoing argument, Appellant notes that the cited portions of Kaplan do not support the proposition of using the VBI for receiving both internet data and program guide data. First, column 3, lines 8-10 of Kaplan state only that “channel information can be received by the present invention while connected to the Internet.” Column 4, lines 33-41 of Kaplan describe the VBI and indicate that URL Internet addresses may be embedded therein. Column 6, line 66 through column 7, line 3 of Kaplan state only that an optional text field of an information block encoded within the VBI is used to provide “a descriptive, informational or promotional message to the viewer about the Internet site associated with the broadcast.” Appellants note that this “descriptive, informational or promotional message . . . about the Internet site associated with the broadcast” is not program guide data. Accordingly, Kaplan does not teach that the VBI can be used for receiving both internet data and program guide data, as alleged by the Examiner, and Appellants maintain the position that modifying Schein using the teachings of Kaplan would at least partially defeat one of the primary objectives of Schein, namely, the ability to receive and process program guide information from multiple sources including cable box 16. For this reason alone, the instant rejection should be reversed.

Even if Schein could be properly modified using the teachings of Kaplan (which it can not), Appellant notes that cable box 16 of Schein (the alleged “stand-alone internet

receiver”) fails to perform all of the recited steps provided by the “stand-alone internet receiver” of claim 1. For example, the Examiner relies on DBS source/IRD box 18 of Schein as corresponding to the claimed “stand-alone digital video receiver” (see page 4 of Office Action dated September 25, 2006). However, Appellant notes that cable box 16 of Schein (the alleged “stand-alone internet receiver”) does not receive program guide information from DBS source/IRD box 18 (the alleged “stand-alone digital video receiver”), as required by claim 1. In response the Examiner alleges that Schein discloses this feature at column 4, lines 49-53 (see page 3 of Office Action dated September 25, 2006). However, this passage of Schein states that coordinator 14, not cable box 16 (the alleged “stand-alone internet receiver”), receives and arranges program schedule information. Accordingly, cable box 16 of Schein (the alleged “stand-alone internet receiver”) fails to perform the step of “receiving the second program guide information from the stand-alone digital video receiver” as claimed.

Moreover, cable box 16 of Schein (the alleged “stand-alone internet receiver”) fails to integrate program guide information received from DBS source/IRD box 18 (the alleged “stand-alone digital video receiver”) with its own received program guide information. Rather, as indicated above, column 4, lines 49-53 of Schein teach that coordinator 14, not cable box 16 (the alleged “stand-alone internet receiver”), receives and arranges program schedule information. Accordingly, cable box 16 of Schein (the alleged “stand-alone internet receiver”) also fails to perform the step of “integrating the first program guide information with the second program guide information to form the combined program guide” as claimed. In view of the foregoing remarks/arguments, Appellant respectfully requests that the Board reverse the rejection of claims 1-2 and 5.

Re: Claims 3-4

The rejection of claims 3 and 4 under 35 U.S.C. §103(a) based on the proposed combination of Schein, Kaplan and Sampsell should be reversed since Sampsell is unable to remedy the deficiencies of Schein and Kaplan pointed out above with reference to claims 1-2 and 5. That is, Sampsell is unable to remedy the resultant problems to television schedule guide system 10 of Schein when modified in the proposed manner using the teachings of Kaplan, as described above. Sampsell is

further unable to remedy the failure of Schein's cable box 16 to perform all of the claimed steps, as described above. Accordingly, Appellant respectfully requests that the Board reverse the rejection of claims 3-4.

VIII. Claims Appendix

1. In a stand-alone internet receiver for receiving internet data and analog program information including first program guide information, coupled to a stand-alone digital video receiver for receiving digital program information including second program guide information, a method for forming a combined program guide comprising steps of:

receiving the first program guide information from a first signal source;

receiving the second program guide information from the stand-alone digital video receiver, wherein the stand-alone digital video receiver receives the second program guide information from a second signal source;

integrating the first program guide information with the second program guide information to form the combined program guide; and

outputting data representative of the combined program guide to a display device.

2. The method of claim 1, wherein the stand-alone digital video receiver receives the second program guide information via a digital data stream, and the stand-alone internet receiver receives the first program guide information via a vertical blanking interval of an analog signal.

3. The method of claim 1, further comprising a step of linking a communications input/output port of the stand-alone digital video receiver with a communications input/output port of the stand-alone internet receiver, wherein the linking step includes establishing at least one of a lower speed data bus and a higher speed data bus.

4. The method of claim 3, wherein the higher speed data bus is clocked by a signal from the stand-alone digital video receiver.



5. The method of claim 1, wherein the stand-alone digital video receiver comprises a satellite receiver.

IX. Evidence Appendix

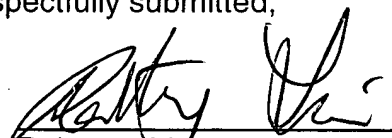
None.

X. Related Proceedings Appendix

None.

Please charge the fee for this Appeal Brief to Deposit Account 07-0832.

Respectfully submitted,


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January 5, 2007

CERTIFICATE OF MAILING

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop Appeal Brief, Commissioner for Patents, Alexandria, Virginia 22313-1450 on:

1-5-07
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Karen Schenck